text-only content, prioritizing communications and varying preferences for an application.

45.   (New) A computer program product according to Claim 37, wherein the computer readable program code which automatically modifies content comprises computer readable program code which performs at least one of removing color components of the content, removing graphics information to provide text-only content, prioritizing communications and varying preferences for an application.

REMARKS

In response to the Official Action mailed November 7, 2000, Applicants have cancelled Claims 1, 3-6, 14, 15, 17-20, 28, 29, 31-34 and 42. Applicants have also amended Claims 2, 7 and 8 to depend from Claim 9, Claims 16, 21 and 22 to depend from Claim 23 and Claims 30, 35 and 36 to depend from Claim 37. Applicants have also removed the "means for" recitations from the pending computer program product claims.

Applicants have also added Claims 43 through 45 which expressly recite types of content modification according to embodiments of the present invention. Support for such claims may be found at page 15 of the present specification.

Th Obviousness Rejection

Claims 1-42 stand rejected as obvious under 35 U.S.C. § 103 in light of United States Patent No. 4,586,134 to Norstedt (hereinafter "Norstedt") and United States Patent No. 5,553,242 to Russell *et al.* (hereinafter "Russell"). For the reasons discussed below, Applicants submit that the claims are patentable over Norstedt and Russell.

To establish a prima facie case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claim, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

reference or to combine reference teachings. M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01, citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). As recently emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be **clear and particular**, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In an even more recent decision, the Court of Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be **particular** evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, **would have selected these components for combination in the manner claimed**. *In re Kotzab*, 55, USPQ2d 1313, 1317 (Fed. Cir. 2000).

The Claim Amendments

Applicants have cancelled Claims 1, 15 and 29 and, therefore, the rejection of these claims is moot. Accordingly, Applicants will address below the rejection of pending independent Claims 9, 23 and 37 and the claims which depend from them.

Independent Claims 9, 23 and 37 are Patentable

In rejecting Claims 9, 23 and 37 the Official Action cites to the abstract, Figures 1, 6 and 8,column 5, lines 34-65 and claim 8 of Norstedt as teaching "a method/system/program for controlling content provided to a device of a user of a network comprising modifying the content provided by the network device to the device based on the policies and the provided session dependent information." Official Action, p. 5. The Official Action acknowledges that Norstedt fails "to teach providing session dependent information associated with the device to the network device having stored policies which are based on the session dependent information" and relies on the abstract, Figures 1-3, column 3, lines 33-65, column 6, lines 37-49 and column 8 lines 30-51 of Russell for teaching such recitations. Official Action, pp. 2-3. As for the motivation to combine the references, the Official Action states that "it would have been obvious ... to modify Norstedt's inventive concept to include

Russell et al's method/system/program providing session dependent information associated with the device to the network device having stored policies which are based on the session dependent information because this would have helped avoiding potential security problem in that all application/operating system accessed is controlled so that false accessed would not penetrate security system." Official Action, p. 5.

Respectfully, as discussed below, the Official Action fails to meet the requirements for a showing of obviousness under § 103. The cited references do not disclose or suggest the use of stored rules to modify content based on session dependent information. In particular, Claim 9 recites:

> 9.   A method of controlling content provided to a device of a user of a network, the method comprising:
> providing session dependent information associated with the device to a network device having stored policies which are based on the session dependent information; and
> automatically modifying the content provided by the network device to the device based on the policies and the provided session dependent information.

Similar recitations are found in Claims 23 and 37. Applicants respectfully submit that the recitations of these claims are not found in the cited references and, in any event, the references may not be properly combined to result in the recitations of Claims 9, 23 or 37.

In particular, Norstedt describes a system for sharing a session among multiple data terminals. However, Norstedt does not describe a system where session dependent information associated with a device of a user is used to modify the content provided to a device. The cited abstract of Norstedt recites that a host processor node "defines the communication rules to be used" and that these rules can be shared by a third user node but does not specify that the **rules modify the content based on session dependent information**. Norstedt, Abstract. Similarly, column 5, lines 34-65 of Norstedt describe how a session is established between a cluster controller and a host processor. Norstedt does describe the use of "session parameters" which specify the rules to be used for communications between the host processor and the cluster controller, however, while the rules may change the handshaking or controls for

transmitting information from the host to a terminal, they do not change the **content**
of the information. Merely changing what protocols are used for a transmission does
not modify the content that is transmitted, only the way the transmission occurs. As
such, Norstedt does not disclose or suggest modification of content based on stored
rules as is recited in Claims 9, 23 and 37.

Similarly, to the extent that the rules applied are only defined by the
negotiation of the session parameters, then the "rules" of Norstedt are not stored
policies as is recited in Claims 9, 23 and 37. Claim 8 of Norstedt also fails to disclose
or suggest either that the policies are stored policies, and therefore, defined prior to a
session being established, or that the policies control the modification of content
based on the characteristics of an instance of an operating environment.

As discussed above, the "rules" in Norstedt only serve to allow the ends of the
session to know the parameters used for the session so that the communications may
be properly interpreted. Accordingly, Applicants submit that Norstedt fails to
disclose or suggest at least the following highlighted portions of Claim 9:

> 9.   A method of **controlling content** provided to a device of a user
> of a network, the method comprising:
>   **providing session dependent information** associated with the device
> **to a network device having stored policies which are based on the session
> dependent information**; and
>   **automatically modifying the content provided by the network
> device** to the device **based on the policies and the provided session
> dependent information.**

Similar recitations are found in Claims 23 and 37.

The Official Action further relies on Russell as providing the teachings
missing from Norstedt. However, the cited portions of Russell do not mention
modifying content provided by the network device as described above and, therefore,
does not disclose or suggest the recitations of the claims which are not taught by
Norstedt.

In addition to failing to disclose or suggest each of the recitations of amended
Claims 9, 23 and 37, Applicants also submit that the motivation to combine alleged in
the Official Action does not provide the clear and particular evidence that the
reference would be combined in the manner claimed which is required by the Federal

Circuit. The only basis given for combining the references is that such a combination would avoid a potential security problem. However, none of the cited portions of the references mentions a security problem. To the extent that Russell describes user authentication and access parameters, it does not describe user authentication to modify content as described above. Furthermore, to the extent that the cited portions of Russell describe determining a client for a session, this information is not used to modify content but is merely used as routing for creation and maintenance of the session. It is also unclear of why content modification as recited in the claims would need the authorization as described by Russell. As such, Applicants submit that the references do not provide a motivation to combine the routing aspects of Russell with the session parameters aspects of Norstedt. and is done in the Official Action. Accordingly, Applicants submit that Norstedt and Russell may not be properly combined to result in the recitations of Claims 9, 23 and 37.

As discussed above, neither Norstedt nor Russell disclose or suggest each of the recitations of Claims 9, 23 and 37. Furthermore, Norstedt and Russell may not be properly combined to result in the recitations of these claims. Accordingly, Applicants submit that Claims 9, 23 and 37, and the claims which depend from them, are patentable over Norstedt and Russell and request allowance of these claims.

Claims Depending from Claims 9, 23 and 37 are Separately Patentable

While each of the claims which depend from Claims 9, 23 and 37 are patentable as depending from a patentable base claims, certain of the dependent claims are separately patentable over Norstedt and Russell. For example, Claims 2, 16 and 30 (which have been amended to depend from Claims 9, 23 and 37) each recite that the session dependent information on which content modification is based is "at least one of a type of network connection, a type of device connected to the network, a user identification of the user and an identification of an application executed by the user." The cited portions of Russell, however, do not describe determining the type of network connection, the type of device connected to the network, a user identification or an identification of an application executed by the user. Furthermore, neither Russell nor Norstedt describe modifying content based on

such information. While Russell does describe determining authorization and access rights for a user, Russell does not describe modifying content provided to a device based on such determinations. Accordingly, Applicants submit that Claims 2, 16 and 30 are separately patentable over Norstedt and Russell for at least these additional reasons.

Claims 7, 21 and 35 (which have also been amended to depend from Claims 9, 23 and 37) each additionally recite "storing the policies on a second network accessible device" and "obtaining the policies from the second network accessible device in response to the network device being provided the session dependent information." Neither Russell nor Norstedt discloses such a division of where policies are stored and where content is modified. Furthermore, the cited portion of Norstedt does not describe providing policies from one network device to another as recited in the claims. As such, Applicants submit that Claims 7, 21 and 35 are separately patentable over the cited references for at least these additional reasons.

Claims 18, 22 and 36 depend from Claims 7, 21 and 35 and are, therefore, separately patentable for at least the reasons discussed above. However, these claims also recite that the policies are stored on an on-demand server. The Official Action does not even address such recitations of these claims. Accordingly, Claims 18, 22 and 36 are separately patentable for at least these additional reasons.

With regard to Claims 10, 24 and 38, these claims each recite that the modification of the content comprises "automatically **translating content** of a communication provided to the device associated with the user **from a first language to a second language**." The Official Action completely ignores the recitations of the claims that the translation is from one language to another. Neither Norstedt nor Russell mention anything about translating content from one language to another and the Official Action fails to even suggest why or how these references could be modified to perform such a translation. Accordingly, Applicants submit that Claims 10, 24 and 38 are separately patentable for at least these additional reasons.

Claims 11, 25 and 39 depend from Claims 10, 24 and 38 and, therefore, are separately patentable for the reasons discussed above. However, these claims also recite that the session dependent information from which the determination of

whether to modify the content to translate from one language to another is "at least one of a type of network connection, a type of device connected to the network, a user identification of the user and an identification of an application executed by the user." Neither Norstedt nor Russell suggest basing such a language translation on any of the network connection, the type of device, a user identification or an identification of an application. As such, Applicants submit that Claim 11, 25 and 39 are separately patentable for at least these additional reasons.

Claims 12, 26 and 40 each recite that "the policies comprise policies which control at least one of characteristics of a network connection, characteristics of content associated with a device utilized by the user, and preferences associated with an application utilized by a user." Neither Norstedt nor Russell suggest using policies for the control of the items identified in these claims. Accordingly, Applicants submit that Claims 12, 26 and 40 are separately patentable for at least these additional reasons.

Finally, Claims 13, 27 and 41 each recite that "the content controlled by the policies is controlled based on at least one of a type of network connection, a type of device connected to the network, a user identification of the user and an identification of an application executed by the user." Such recitations are also not found in Russell or Norsted and, therefore, Applicants submit that these claims are also separately patentable for at least these additional reasons.

The Newly Added Claims Are Separately Patentable

Applicants have submitted new Claims 43 through 45. Claim 43 recites the following:

> 43. (New) A method according to Claim 9, wherein the step of automatically modifying content comprises at least one of removing color components of the content, removing graphics information to provide text-only content, prioritizing communications and varying preferences for an application.

Similar recitations are found in Claims 44 and 45. Applicants submit that such modification of content is neither disclosed nor suggested by the cited references.

Accordingly, Applicants submit that Claims 43 through 45 are separately patentable over the cited references for at least these additional reasons.

Conclusion

Having addressed each of the issues raised in the Official Action, Applicants submit that the present application is in condition for allowance, which action is respectfully requested.
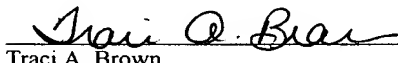
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box NON-FEE Amendment, Commissioner for Patents, Washington, DC 20231, on January 26, 2001.

Traci A. Brown
Date of Signature: January 26, 2001